

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA**

IMPINJ, INC.,

Plaintiff,

v.

NXP USA, INC.,

Defendant.

Case No.: 19-CV-3161 YGR

**ORDER CONTINUING COMPLIANCE
DEADLINE; LIFTING STAY IN PART**

The parties have filed a joint statement regarding the status of proceedings on *inter partes* review. (Dkt. No. 64, [“Statement”].) In that Statement, they recount the following:

On February 18, 2020, Impinj filed a First Amended Complaint narrowing the accused patents to specified claims in eight patents: the ‘816, ‘266, ‘298, ‘504, ‘302, ‘631, ‘597, and ‘857 patents. (FAC, Dkt. No. 53.). NXP filed IPR petitions as to all eight patents and thereafter the parties stipulated to a stay pending the IPRs, entered on March 30, 2020.

The PTAB has now issued decisions on six of the eight petitions. Thus, the patents’ status is as follows:

‘597, ‘631, ‘302, ‘266	petitions denied
‘298 and ‘816	petitions granted
‘504 and ‘857	petitions granted, but Impinj “dropped all asserted claims” after the filing of the IPR petitions

(Statement at 2.)

Based on the parties’ Statement, the Court **ORDERS** as follows:

1 1. The informal request to lift the stay as to the ‘631 and ‘302 patents is **GRANTED**.
2 NXP’s IPR petitions have been denied and there is no overlap with the continued IPR proceedings.

3 2. The informal request to amend the complaint to add two additional patents that were
4 previously dismissed is **DENIED** given the prejudice to NXP since the one-year IPR clock has now
5 expired. Should Impinj choose to dismiss its claims against the ‘298 and ‘816 patents as it suggests
6 (Statement at 5:20-22), the parties should file a stipulation and proposed order to do so.

7 3. With respect to the ‘597 and ‘266 patents, given the asserted overlap with the ‘857
8 and ‘816 patents which are the subject of continuing IPR proceedings, the parties are **ORDERED** to
9 meet and confer further to determine what can be done to permit the case to proceed expeditiously
10 once a final decision on the IPR is rendered next year.

11 The parties shall file a further status statement or stipulation no later than October 9, 2020,
12 which shall include a proposed schedule consistent with the local rules. The current compliance
13 deadline of September 25, 2020 is **CONTINUED** to **October 16, 2020** on the Court’s 9:01 a.m.
14 compliance calendar.

15 To the extent the parties require a conference with the Court, they should so request.

16 **IT IS SO ORDERED.**

17 Date: September 24, 2020


YVONNE GONZALEZ ROGERS
UNITED STATES DISTRICT COURT JUDGE